

Appl. No. 10/590,259  
Response to Office Action mailed July 2, 2008

Atty Dkt. No. 115975-002

### **REMARKS**

The non-final Office Action was issued on pending claims 1-8. Claims 1, 2 and 5-8 stand rejected and claims 3 and 4 were withdrawn from consideration. In this Response, claims 1 and 2 have been amended and no claims have been added or cancelled. Thus, claims 1-8 are pending in the application of which claims 1, 2 and 5-8 are under consideration and claims 3 and 4 are withdrawn from consideration.

Applicants invite the Examiner to call Applicants' Representative to discuss any issues with this application.

#### **Claim Rejections – 35 USC §112, 1<sup>st</sup> paragraph**

At paragraph 5 of the Office Action, claims 1, 2 and 5-8 were rejected under 35 U.S.C. §112, 1<sup>st</sup> paragraph, as failing to comply with the written description requirement. The Office Action specifically refers to claim 1, line 7.

In response, claim 1 has been amended as suggested in the Office Action. Claim 1 now recites "a punch auxiliary tool having an auxiliary tool station and a pair of arms rising from both sides of the auxiliary tool station." The amendment is supported by the specification at paragraphs [0046] and [0070] and Fig. 6.

Therefore, Applicants submit claims 1, 2 and 5-8 comply with the written description requirement.

Thus, Applicants submit that the §112, 1<sup>st</sup> paragraph, rejections have been overcome.

#### **Claim Rejections – 35 USC §112, 2<sup>nd</sup> paragraph**

At paragraph 7 of the Office Action, claims 1, 2 and 5-8 were rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action specifically refers to claim 1, lines 7 and 11, claim 2, line 2, and claim 5, line 4.

In response, claims 1 and 2 have been amended to clarify the claims. Claim 5 has not been amended because claim 5 has been withdrawn from consideration.

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As to claim 1, line 7, claim 1 has been clarified as mentioned above regarding the §112, 1<sup>st</sup> paragraph, rejection.

As to claim 1, line 11, claim 1 has been amended to recite "an inserting/detaching opening is formed on a side of the punch auxiliary tool where the pressing operating member is pivotally supported such that the inserting/detaching opening is open and accessible to outside of the punch auxiliary tool when the pressing operating member is pivoted toward the auxiliary tool station, the inserting/detaching opening capable of inserting and detaching the punch in such a state that a side of the punch where the slit is formed is directed to the side of the punch auxiliary tool where the pressing operating member is pivotally supported." Applicants submit the amended claim text is clear and definite.

As to claim 2, line 2, claim 2 has been amended as suggested in the Office Action.

Therefore, Applicants submit claims 1, 2 and 5-8 are clear and definite.

Thus, Applicants submit that the §112, 2<sup>nd</sup> paragraph, rejections have been overcome.

#### **Claim Rejections – 35 USC §102, §103**

At paragraph 9 of the Office Action, claims 1 and 2 were rejected under 35 U.S.C. §102(b) as being anticipated by Lee (US 6,089,137).

At paragraph 12 of the Office Action, claims 5-8 were rejected under 35 U.S.C. §103(a) as being anticipated by Lee (US 6,089,137) in view of Mori et al. (US 4,509,397). Applicants respectfully disagree.

Claim 1 has been amended to clarify the claim. Amended claim 1 calls for "an inserting/detaching opening is formed on a side of the punch auxiliary tool where the pressing operating member is pivotally supported such that the inserting/detaching opening is open and accessible to outside of the punch auxiliary tool when the pressing operating member is pivoted toward the auxiliary tool station, the inserting/detaching opening capable of inserting and detaching the punch in such a state that a side of the punch where the slit is formed is directed to the side of the punch auxiliary tool where the pressing operating member is pivotally supported." (Emphasis supplied).

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Referring to Figs. 1 and 6, an inserting/detaching opening 31 is formed on a side of the punch auxiliary tool 3 where the pressing operating member 40 is pivotally supported such that the inserting/detaching opening 31 is open and accessible to outside of the punch auxiliary tool 3 when the pressing operating member 40 is pivoted toward the auxiliary tool station 30. The inserting/detaching opening 31 is capable of inserting and detaching the punch 1 in such a state that a side of the punch 1 where the slit 11 is formed is directed to the side of the punch auxiliary tool 3 where the pressing operating member 40 is pivotally supported. See also Applicants' specification at paragraphs [0046], [0082-0083] and [0091].

Turning to Lee, one feature of Applicants' invention that is quite different from the corresponding structure in Lee is the structure of Applicants' invention that allows the punch 1 to be inserted into and removed from the punch auxiliary tool 3. In Applicants' invention, the punch auxiliary tool 3 has a structure which allows the punch 1 to be inserted into and removed from the punch auxiliary tool 3 while the pressing operating member 40 is rotated towards the auxiliary tool station 30. The punch auxiliary tool 3 has an inserting/detaching opening 31 for inserting and detaching the punch 1. The inserting/detaching opening 31 is provided at an end of the punch auxiliary tool 3 and is open and accessible to outside of the punch auxiliary tool 3 when the pressing operating member 40 is pivoted toward the auxiliary tool station 30. This allows the inserting/detaching opening 31 to be used while the pressing operating member 40 is rotated towards the auxiliary tool station 30. Conversely, in Lee the handle 10 must be lifted upward (rotated away from the base 30) a great distance to insert/remove an assembly of a cover 60, an inner punch 56, and outer punch 50, a core 40 and abutting member 70 and a supporting member 80 into/from a housing 320 of the base 30. See Lee, column 5, lines 17-22 and Figs. 3, 7 and 8.

Furthermore, Applicants submit it would not be obvious to modify Lee to result in Applicants' claimed invention. Lee has a pivot 322 extending from a front wall of the housing 320 for pivoting the handle 10 which prevents an inserting/detaching opening from being located at the front side of the housing 320. See Lee Figs. 2, 3 and 5-8.

The Lee paper punch having a handle 10 which must be pivoted upward a great distance away from the base 30 to insert and remove the punch can have disadvantages. For example, it can be troublesome to exchange the punch in the Lee device because the handle 10 must be brought to a higher than normal position. See Applicants' specification at paragraphs [0006] and [0012]

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which discuss Lee (patent document 3 is US 6,089,137 to Lee as mentioned at paragraph [0009]).

Conversely, Applicants' invention can provide advantages. For example, it is easy to insert into and remove the punch 1 from the punch auxiliary tool 3. See Applicants' specification at paragraphs [0027], [0028] and [0083].

Therefore, claim 1 is allowable. The dependent claims are allowable at least for the reasons that claim 1 is allowable.

Thus, Applicants respectfully submit the §102 and §103 rejections should be withdrawn.

### CONCLUSION

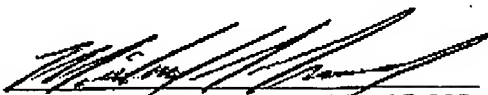
For the foregoing reasons, Applicants submit that the patent application is in condition for allowance and request a Notice of Allowance be issued.

Respectfully submitted,

EVEREST INTELLECTUAL PROPERTY LAW GROUP

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